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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,800

02/23/2004

Fausto Pinna

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5473

22850

7590

12/01/2006

C. IRVIN MCCLELLAND

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

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EXAMINER

PETRIK, KARI KRISTEN

ART UNIT

PAPER NUMBER

3772

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/782,800		PINNA ET AL.	
	Examiner		Art Unit	
	Kari Petrik		3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species 1 and 1b in the reply filed on 9/28/2006 is acknowledged. The traversal is on the ground(s) that since the application is an RCE, all subject matter has already been searched and therefore cannot impose an undue burden on the examiner. This is not found persuasive because the previous claims did not require the different polymers and methods of polymerization be searched separately.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 29-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/28/2006.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-26, 28, 34, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kundel (US Patent 5,480,717) in view of Nielsen (WO 02/05737).

5. Regarding claim 21, Kundel discloses hydrogel laminate bandages and composites, thereby disclosing breathable pads (col. 6, lines 14-17), for application to the human skin, to develop a decongestant, cosmetic and/or pharmaceutical action (col. 4, lines 35-40). The pad

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comprises a flexible porous support (col. 4, lines 62-66) having at least one layer of gel applied to a surface. The support can be woven or nonwoven fabrics (column 4, lines 62-67), which are to some extent flexible, porous and breathable. The gel comprises between 50% and 77% of water and between 6.5% and 44% of a dermatologically compatible polymer (polyvinyl alcohol, col. 4, lines 51-54). Kundel does not disclose that the layer of gel is applied directly to the porous support. Nielson teaches applying a hydrogel (2) directly to a support (1) with no adhesive between to obtain the highest permeability (page 5 line 22-page 6 line 2). I would have been obvious to one having ordinary skill in the art at the time of the invention to provide the bandage disclosed by Kundel wherein the hydrogel is applied directly to the support, as taught by Nielsen et al, to provide the maximum permeability throughout the bandage.

6. Regarding claims 22-26, Kundel fails to explicitly teach the thickness and density of the support (substrate, 16), or the type of fibers making up the flexible support. The examiner, however, contends that the claims do not appear to contain any additional features, which in combination with the features of any claim to which they refer, add anything novel. As such, absent a critical teaching and/or a showing of unexpected results, the limitations present in claims 22-26 are considered obvious design choices to one having ordinary skill in the art since it has been held to be within the general skill in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

7. Regarding claim 28, Kundel discloses the polymer is polyvinyl alcohol (column 4, lines 34-35).

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8. Regarding claim 34, Kundel discloses the pad of claim 21 as described above. The claimed phrase “wherein said polymer is polyvinyl alcohol which has been polymerized by the addition of an alkaline metal or alkaline earth metal tetraborate” is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

Thus, even though Kundel does not disclose the process of polymerization alkaline metal, it appears that the product in Kundel would be the same or similar as that claimed; especially since the prior art's gel has the claimed components.

9. Regarding claim 38, Kundel discloses the gel may further comprise at least one dermatologically compatible component which is a soothing, skin repairing, cicatrizing, anti-inflammatory, antiseptic or bactericidal substance (column 4, lines 35-40).

10. Regarding claim 40, Kundel in view of Nielson disclose a method for treating skin for reducing localized swelling or providing decongestant, analgesic or antiedema effect, comprising externally applying the pad of claim 21 to the subject.

11. Claims 27 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kundel in view of Nielson further in view of Caskey (US Patent Application 2004/0127826).

Kundel in view of Nielson teach the claimed invention as outlined in the rejection to claim 21 above. Kundel does not disclose that the breathable pad contain 5wt% to 10 wt% of a substance of plant origin. Caskey teaches a breathable (woven or nonwoven) pad having at least one layer of gel (honey, 7 Figure 3) on at least one surface, wherein the gel comprises a substance of plant origin comprising essential oils and aromatic extracts ([0086] and [0103]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pad of Kundel in view of Mershon, having a substance of plant origin, as taught by Caskey, to provide additional therapeutic properties.

12. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kundel in view of Nielson in view of Caskey in further view of Mershon. Kundel, Nielson and Caskey substantially disclose the claimed invention as applied to claims 21, 22, and 27. Kundel does not disclose the gel comprises an alkaline earth metal tetraborate. Mershon teaches that it is known to use a tetraborate (borate salts) to thicken (gel) polyvinyl alcohol [0012]. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a tetraborate to the polyvinyl alcohol, when used, in order to thicken or cause the polyvinyl alcohol solution to gel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is 571-272-8057. The examiner can normally be reached on M-Th and every other Friday, 7-4:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kari Petrik
Examiner
Art Unit 3772

KKP


11/27/09